

## REMARKS

### II. Rejections under 35 USC §102

Claims 12-15, 18 and 21-27 have been rejected under 35 USC §102(a) as being anticipated by Kimura et al. US Patent No. 5690916. The rejection is stated as follows:

Kimura discloses a foundation comprising 9.0% by weight of blue interference pigments and iron oxides, 11% by weight of titanium dioxide, and sericite, other non-interference inorganic pigments which examiner views are used to match skin tone and thus meet the “skin color” limitation.

Since claimed composition is disclosed in the prior art, examiner take the position that the claimed method of reducing wrinkles is inherently practiced by the prior art method of topically applying the same composition. Examiner takes the position that ... wrinkle and lines inherently form in facial skin as a natural phenomena caused by the movement of facial muscle. See instant claim 7.

Applicants respectfully disagree with the Examiner’s position that the claimed method is inherently practiced by the prior art method of topically applying “the same composition”. First, as regards the analysis of the composition claims 21-27, with respect to Kimura, the Examiner’s statement that the composition of Kimura are used to match skin tone, and therefore meet the “skin color” limitation, is simply incorrect and a misconstruction of the teachings of Kimura. The Kimura compositions are intended not to match the skin color, but rather to complement the discoloration to be found on the skin. This does not make the composition skin colored, and in fact, the disclosure overall in Kimura is intended to produce a composition that is essentially transparent on the skin. The fact that the composition is intended to adjust the skin color does not necessarily make the composition *per se* skin colored, and indeed, a careful reading of the reference will show that the Kimura compositions are intended to “adjust” skin color not by mimicking it or physically hiding its discolorations, but by optically altering the viewer’s perception of the discolored portions. Thus, any assumption that the compositions of Kimura are skin-colored is misplaced, and certainly finds no basis in the express teachings of the document. In the absence of any evidence from the document that the compositions are skin-colored, and in view of the clear-cut teachings against such a composition, a rejection based on anticipation of claims 21-27, 29, 30 and 32 cannot be sustained.

With regard to the method claims 12-15, and 18, the Examiner’s inherency analysis alone is so far off the mark that, whether or not Kimura discloses compositions that are the same or similar to those employed in the present method, it alone is enough to cause the failure of the rejection. First, the

Applicants' claims do not simply require the application of the composition to the skin; it is required that the composition be applied to skin "exhibiting lines and wrinkles". It is clear that the Kimura document does not make any disclosure whatsoever as to the application of the composition disclosed therein to skin exhibiting lines and wrinkles, so clearly there is no express anticipation of the claims by this document. It appears to be the Examiner's "position" that because any skin will eventually form wrinkles, the disclosure of the Kimura reference inherently results in the application of the composition to skin containing lines and wrinkles and thus will in turn inherently result in a reduction of appearance of lines and wrinkles.

This position fails on two counts, each important in showing the flaws in the rejection. First, from a purely technical point of view, the Examiner cannot seriously be taking the position that lines and wrinkles associated with aging form on every skin surface, and exist on every possible user of the Kimura composition, but this is what would be required in order to meet the inevitability standard that is mandatory in making a case for inherency: a finding of inherency requires that the intended result must undeniably and irrefutably flow from the prior art disclosure. *Hughes Aircraft Co. v. United States*, 8 USPQ 2d 1580 (Ct. Cl. 1988). The Examiner's simply taking a position, with no technical backup, and in complete contradiction of facts, will not suffice to meet the requirements of inherency.

The law with respect to establishing anticipation by inherency is quite clear, and the Examiner has chosen to ignore it. The Examiner is respectfully referred to *Continental Can Co. v. Monsanto*, 20 USPQ 2d 1746 at 1749, wherein it is stated:

To serve as anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (emphasis added)

The Examiner has failed utterly in showing that the application of the Kimura composition in the manner disclosed in Kimura would necessarily result in the applications of the composition to age-wrinkled skin. Any extrinsic evidence provided must show conclusively that the prior art produced the claimed subject matter. *Schering Corporation v. Geneva Pharmaceuticals Inc.*, 67 USPQ 2d, 1664 (Fed. Cir. 2003). In fact, the Examiner has not even attempted to provide any extrinsic evidence at all, instead simply relying on a self-serving "position" that is unsupported by extrinsic evidence other than the Examiner's personal opinion. This is clearly inadequate to meet the legal requirements for an anticipation by inherency rejection.

Is it possible that in following the disclosure of Kimura one might by happenstance end up applying the composition to a wrinkle? For the sake of argument, Applicants will concede that such an

occurrence is not out of the realm of possibility, simply by accidental overlap of a wrinkled area of skin with a hyperchromatic portion, which is the skin target of Kimura, although it would be a completely random, undirected occurrence. Even assuming that this is a possibility, however, this is also legally inadequate to support a conclusion of anticipation. Accidental occurrences of the claimed subject matter, not intended and not appreciated, do not constitute anticipation. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 US 45, 66 (1923). In the absence of any teaching whatsoever in Kimura that the composition should be applied to age-wrinkled skin, and in the absence of any showing by the Examiner that all skin necessarily bears age-related wrinkles, then the actual occurrence of the application of the composition is unequivocally accidental and random, and therefore, such occurrence is by law inadequate to constitute anticipation.

Since the rejection is inadequately supported as a matter of law, as well as a matter of fact, the rejection cannot stand and must be withdrawn.

#### Rejection under 35 USC §103

Claims 19 and 33 have been rejected under 35 USC §103(a) as being unpatentable over Kimura as applied to claims 12-15, 18, and 21-27, 29, 30 and 32, which are alleged to be anticipated by Kimura.

The rejection is stated as follows:

While the reference fails to disclose using less than 9% of the blue interference pigments, examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. MPEP §2144.05. Since the general conditions of the instant claims are disclosed in Kimura, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Lowering the concentration of an active component also is viewed economically advantageous from the perspective of a manufacturer.

Since the Examiner has applied the Kimura reference here as applied above, the same arguments raised above apply here. To reiterate briefly, the Kimura reference does not, either expressly or inherently, anticipate the present claims, because the reference does not teach or suggest, expressly or inherently, the application of a composition to age-wrinkled skin, to cause a reduction in the appearance of the wrinkles. In the rejection of claims 19 and 33, the Examiner takes a position that it would have been obvious to use a different percentage of interference pigment than disclosed in Kimura for optimization, citing the MPEP to support this position. Notwithstanding the fact that the MPEP has no force of law, the statements therein would in any case not apply to the present situation. If the cited section of the MPEP are read carefully, it will be seen that the position is directed to a situation in which the claimed method is the same as disclosed in the prior art, differing only in the percentage range of

components employed. It does not apply to the present situation, however, wherein the methods are completely different. The prior art reference discloses a method of disguising a skin flaw by applying a composition containing an interference pigment to a hyperchromatic or discolored portion of skin, whereas the present method is a method of reducing the appearance of age-related lines and wrinkles which comprises applying a composition containing interference pigments to skin exhibiting lines or wrinkles. The methods are clearly not the same, and therefore, in the absence of anything in the prior art relating to the reduction in appearance of wrinkles, one skilled in the art would have no expectation that any teaching relating to disguising discolored skin would be relevant to the disguising of wrinkles. This is not a situation of mere optimization of a known method. If the Examiner cannot provide some other basis for establishing the amounts used in the present claims would have been obvious in view of Kimura's disclosure for a completely different method, this rejection must be withdrawn.

Claims 1-7, 9 and 10 have been rejected under 35 USC §103(a) as being unpatentable over Kimura as applied above, and further in view of Hineno, US Patent No. 6207174. The rejection states:

Kimura...fails to teach using the composition to visibly reduce wrinkles or lines on the skin. Examiner views that wrinkles cause by chronicle [*sic*] aging is a natural phenomena that is obviously present in mature users' skin. Thus, examiner takes the position that the prior art composition, when used by the users with aged skin, obviously renders the wrinkle minimizing effect which applicants claim.

Hineno teaches using a composite powder comprising interference or reflective pigments useful in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3....

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the Kimura composition as motivated by Hineno because of the expectation of successfully enhancing w[r]inkle-coverage effect and improving skin color tone.

To once again rebut the rejection as it applies to Kimura, the Examiner's position regarding the application to aged skin is misplaced. Kimura suggests only to apply the composition in question to discolored skin, not wrinkled skin, and therefore, there is no expectation from this reference that the reduction in appearance of wrinkles would be achieved, even if used by individuals with aged skin, since presumably such individuals will have at least some areas of skin that is not wrinkled, and those discolored areas of skin that Kimura recommends application to do not necessarily, or even likely, overlap with wrinkled skin. On this basis alone, the rejection fails.

Hineno provides no teaching to remedy this defect in Kimura. Notwithstanding the Examiner's assertion that Hineno teaches an interference powder that is "useful in covering wrinkles", Applicants have reviewed the citations the Examiner has provided in Hineno and finds no such teaching. The sole teaching Applicants find regarding the utility of the Hineno powders is in altering the color of the

composition, and the skin to which it is applied. No mention is made of hiding wrinkles or lines, or application of the powders to aging skin containing wrinkles. If the Examiner wishes to maintain this position, Applicants respectfully request a more specific citation as to where the reduction in appearance of wrinkles can be found in Hineno. Failing this, the rejection of claims 1-7, 9 and 10, in view of Kimura and Hineno, cannot be sustained for the same reasons the previous rejections cannot be sustained: there is no teaching, either express or implied, to be found in either Kimura or Hineno, for the application of a blue or violet interference pigment to age-wrinkled skin to disguise the appearance of those wrinkles. Therefore, the rejection must be withdrawn.

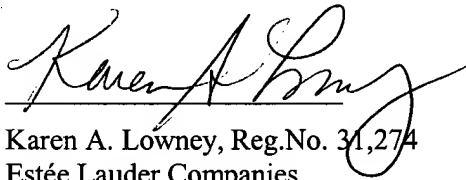
Claims 8, 16, 17, 20, 28, 31 and 34 have been rejected under 35 USC §103(a) as being unpatentable over Kimura and Hineno as applied above, further in view of Hurst (Face Powders, Poucher's Perfumes, Cosmetics and Soaps). The rejection notes that Kimura and Hineno fail to teach bismuth oxychloride, but that Hurst teaches that bismuth oxychloride was the first synthetic pearlescent pigment and that it is possible to use pearlescent pigment to provide "translucent luster". The Examiner states it would have been obvious to modify the compositions of Kimura and Hineno by adding bismuth oxychloride with an expectation of producing a composition with luster or frosted effect to enhance the "natural look" of the user.

The inadequacy of the Kimura and Hineno references have been discussed above. Hurst provides no further disclosure which would remedy the flaws of Kimura and Hineno with respect to any of the claims against which they have been applied. The mere disclosure of bismuth oxychloride, when the primary elements of the claims have not been shown to be either anticipated or obvious, cannot then itself render the claims obvious. Since the claims in question depend directly from claims shown above to be unobvious in view of the cited references, the dependent claims must also be found unobvious. *In re Fine*, 5 USPQ 2d 1596 (Fed.Cir. 1988). Withdrawal of the rejection is therefore respectfully requested.

**CONCLUSION**

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,

A handwritten signature in cursive script, reading "Karen A. Lowney", is written over a horizontal line.

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